

REMARKS/ARGUMENTS**The Office Action**

In the above-mentioned non-final Office Action, claims 265-268 were rejected as failing to comply with the written description requirement and claims 181-186, 188-194, 197-212, 214-234, 236-264 and 269-271 were rejected as being anticipated by U.S. Patent 6,380,132 (Mihara *et al*).

In response thereto, dependent claims 265-268 have been cancelled without prejudice or disclaimer.

Additionally, six Requests for the Examiner are set forth below at the end of the Remarks/Arguments section.

The Section 112 Rejections

Since claims 265-268 have been cancelled, the Section 112 rejections are moot.

Improper Claim Construction Used in the Office Action

On pages 4 – 6 of the final Office Action, the Examiner held that a number of claim features were not "positive limitations" because they only "require the ability to so perform." He then accorded those features no patentable weight. He did not contend that those features presented 112, 102 or 103 issues, he simply dismissed them.

These claim features/phrase/terms include in claim 181 "the multi-layered sheet and the (first) cut line being constructed and adapted to cause the sheet structure or a portion thereof to split on at least a portion of the (first) cut line when the sheet structure or a portion thereof is bent on the (first) cut line upwardly only once or downwardly only once".

They include in claim 200 "at least one of the first and second layers being selected and constructed, and the cut lines being configured, such that the sheet can be bent upwardly only once, or downwardly only once, along at least some of the plurality of cut lines, to thereby be split along the at least some of the plurality of cut lines to separate the sheet portions from the sheet into a plurality of individual sheet portions".

They include in claim 242 "at least one of the first and second layers and the cut lines being structurally capable of causing the sheet when bent upwardly only once, or downwardly only once, along at least some of the plurality of cut lines, to thereby be split along the at least some of the plurality of cut lines to separate the sheet portions from the sheet into a plurality of individual sheet portions." These sheet portions include "a portion of the first layer and a portion of the second layer secured to the portion of the first layer."

Applicants respectfully contend that the Examiner's claim construction "technique" is improper and that there is no support in the law for such technique. Accordingly, all of the features/phrases/terms are positive limitations and must be accorded patentable weight in the further examination of the claims.

In re Hutchinson and Other Case Law and Board Decisions are Contrary to the Claim Construction

In re Hutchinson, 154 F.2d 135 (CCPA 1946), which the Examiner cited and relied on, is clearly not on point. In that case, the claim language was for a laminated article adapted for use in making a template or the like.

First, it is noted that the *Hutchinson* claim language is in the preamble of the claim, while the claim language at issue in the subject application is in the body of the claim.

Second, the *Hutchinson* claim language states potential uses for the claimed material. In contrast, the claim language at issue in the subject application describes properties of the material. Referring to the hypothetical which Applicant's counsel and Applicant's technical representative (Dr. Ugolick) discussed with the Examiner at an earlier personal interview in another application, the claim language at issue here is not "A sheet of business cards adapted for use in business transactions, comprising ... " where according to *Hutchinson* the language "adapted for use in business transactions" would not constitute a limitation in any patentable sense.

Third, a discussion of the state of the law beyond the 1946 CCPA *Hutchinson* decision follows. It will be readily apparent therefrom that the Examiner's claim construction technique is improper.

Again, the claim language at issue in the present application is not in the preamble, but rather in the body of the claim. However, even if it were in the preamble, there is no *per se* rule that it is not accorded patentable weight. Rather it is "a matter to be determined on the facts of each case in view of the claimed invention as a whole." *In re Stencel*, 828 F.2d 751, 754 (Fed. Cir. 1987).

For example, the preambular phrase "an abrasive article" was held to introduce a material limitation in *Kropa v Robie, et al.*, 187 F.2d 150 (CCPA 1951).

The composition of matter claim at issue *In re Swinehart, et al.* 439 F.2d 210 (CCPA 1971) included in its body (not in its preamble) the phrase "transparent to infrared rays." The Examiner and the Board held in rejecting the claim that the claim was improperly functional. In its decision reversing the Board, the Court of Customs and Patent Appeals said:

We are convinced that there is no support, either in the actual holdings of prior cases or in the statute, for the proposition, put forward here, that 'functional' language, in and of itself, renders a claim improper. We have also found no prior decision of this or any other court which may be said to hold that there is some other ground for objecting to a claim on the basis of any language, 'functional' or otherwise, beyond what is already sanctioned by the provisions of 35 U.S.C. § 112.

In re Swinehart, et al., *supra* at 213.

In re Venezia, 530 F.2d 956, 959 (CCPA 1976) in interpreting the claim language "each sleeve of said pair adapted to be fitted over the insulating jacket of one of said cables", said "[r]ather than being a mere direction of activities to take place in the future, this language imparts a structural limitation to the sleeve. Each sleeve is so structured or dimensional that it can be fitted over the insulating jacket of a cable. A similar situation exists with respect to this 'adapted to be affixed' and 'adapted to be

positioned' limitations in the third and fourth paragraphs of the claim." This case is cited in MPEP 2173.05(g) as is the above-discussed *Swinehart* case.

That section of the MPEP reads, in part, as follows:

A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure of specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971) ...

It was held that the limitation used to define a radical on a chemical compound as "incapable of forming a dye with said oxidizing developing agent" although functional, was perfectly acceptable because it set definite boundaries of the patent protection sought. *In re Barr*, 444 F.2d 588, 170 USPQ 33 (CCPA 1971).

In a claim that was directed to a kit of component parts capable of being assembled, the Court held that limitation such as "members adapted to be positioned" and "portions ... being resiliently dilatable whereby said housing may be slidably positioned" served to precisely define present structural attributes of interrelated component parts of the claimed assembly. *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976).

The following are examples of recent opinions of the Board of Patent Appeals and Interferences on this point. (It is noted that each of these opinions is not written for publication and is not binding precedent of the Board.) They are instructive, however, as to how the Board interprets claim language very similar to that at issue here. It will be seen that the Board does not employ the "technique" used by the Examiner herein, but rather considers all similar claim language as introducing positive limitations.

(1) *Ex parte Calhoun, et al.*, Appeal No. 2003-1599, Paper No. 17. Claim language "sized and configured" was held to be a positive structural limitation.

(2) *Ex parte Miller, et al.*, Appeal No. 97 -0972, Paper No. 13, pages 6-7, "[t]he various functional limitations in the claims (e.g., that the elongated member is 'adapted to extend between an armrest assembly and a set member' set forth a function which the apparatus must be structurally *capable* of performing (see, e.g., *In re*

Venezia, 530 F.2d 956, 959, 189 USPQ 149, 151-52 (CCPA 1976)) and such a functional statement must be given full weight and may not be disregarded in evaluating the patentability of the claims (see, e.g., *Ex parte Bylund*), 217 USPQ 492, 498 (Bd. App. 1981))." That is, the Board said that such functional statements must be given full weight and may not be disregarded in evaluating the patentability.

(3) *Ex parte Prall*, Appeal No. 2003-1556, Paper No. 24. The phrase "the removable spacer layer...is adapted to be completely removed when isotropically etched" was held to impose a "capability requirement of part of the claimed semiconductor structure." It was therefore given patentable weight, by the Board, contrary to the Examiner's reliance on *In re Hutchinson*, *supra*.

(4) *Ex parte Brick*, Appeal No. 2000-1794, Paper No. 29, page 5. In reversing the Examiner's rejections of claims 1-11 and 13, the Board referring to *In re Swinehart*, *supra*, said that there is "nothing intrinsically wrong with the use of this ["adapted to be"] technique in drafting a patent claim." This was contrary to the Examiner's arguments that "the recitation that an element is 'adapted to' perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re [Hutchison]*, 69 USPQ 138."

(5) *Ex parte Belisle, et al.*, Appeal No. 2002-2224, Paper No. 33. Claim language "such that the washer is removable from the shaft without breaking the washer or the shaft" was held to be a positive limitation in a patentable sense.

(6) *Ex parte Machida*, Appeal No. 1998-2826, Paper No. 13. Claim language "an elongated plate member adhesively bonded to a surface of a nail shell with an adhesive agent" was found to not be a statement of intended use. Rather, it was held to be "a positive limitation which cannot be ignored in applying prior art."

(7) *Ex parte Ligler, et al.*, Appeal No. 1999-1384, Paper No. 15. Claim language that "the membrane may be rinsed and said device may be reused" was found to further limit the claimed device so that it is to reusable.

(8) *Ex parte Beckage*, Appeal No. 2003-0242, Paper No. 13. The examiner, citing *In re Hutchinson*, *supra*, contended that terminology that an element is "adapted

to" perform a function is not a positive limitation in any patentable sense. The Board disagreed and reversed the examiner. Citing *In re Venezia, supra.*, the Board said that "the scope of the claims can be ascertained with a reasonable degree of precision and particularity."

Accordingly, the above-discussed claim construction technique of the Examiner was improper and his conclusions thus were incorrect, Applicant respectfully contends. Hence all of the claim terms are positive limitations which are to be accorded patentable weight.

The claims herein were rejected under Section 102(e) which clearly requires that all elements and limitations of the claim be disclosed in the reference. Such is not the case. The clauses/phrases/words at issue distinguish the claims over the prior art, including *Mihara*.

Referring to Dr. Ugolick's Declaration:

11. *Mihara et al.* does not describe a construction which splits, divides or separates into attached first and second layer portions when folded, and specifically when folded or bent upwardly only once or downwardly only once, as would be understood by those skilled in the art. Cut 2 of *Mihara* is provided to separate the adhesive label 9 from the release sheet 5. (See Abstract; col. 3, lines 18-21; col. 3, lines 49-54; and col. 5, lines 50-55.) In fact, *Mihara et al.* does not want the release sheet 5 to break or split at the cuts 2 as this would make it more difficult to initiate removal of the labels from the release sheet by separating an easily graspable portion of the label from the release sheet. That is, users want to be able to easily grasp and peel off a unitary predefined sheet adhesive sheet portion or label without fracturing the release sheet in a *Mihara et al.* type of construction. If a portion of the release sheet were to crack and break off and remain adhered to the label, it would defeat the purpose of the *Mihara* cuts 2, which is to facilitate removal of the labels from the release sheet.

12. *Mihara et al.* would not and does not have the ability to split on at least portions of the first, second, third or fourth cut lines when the sheet structure or a portion thereof is bent on the first, second, third or fourth cut lines upwardly only once or downwardly only once, as would be understood by those skilled in the art.

Reliance upon MPEP 2111.04 Would be Improper

If the Examiner is relying upon MPEP 2111.04 for his claim interpretation this also is improper, Applicant respectfully contends. As stated therein whether such clauses are limitations depends on the specific facts of the case; and the present facts justify treating them as limitations. This section then relies upon and cites two cases, the below-discussed *Hoffer* and *Minton* cases. Careful examination of these cases shows that MPEP 2111.04 does not impose any limiting effect on the words/clauses/phrases at issue in the claims in this patent application.

Hoffer v. Microsoft Corp., 405 F.3d 1326, 1329 (Fed.Cir. 2005) says that when "a 'whereby' clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention." That is precisely what the Examiner has done in the present Office Action, that is, ignored conditions material to patentability.

In *Minton v. Nat'l Ass'n of Securities Dealers, Inc.*, 336 F.3d 1373 (Fed. Cir. 2003) the claim at issue was a method claim ("a method for trading securities between individuals") and the clause at issue was "executing a trade of the security ... whereby the security is traded efficiently between the first individual and the second individual." No weight was given to the "traded efficiently" phrase because a "whereby clause is not given weight when it simply expresses the intended result of a process step positively recited" and is a laudatory phrase characterizing the result. Clearly, the *Minton* case does not apply to the facts in the present application.

Requests of the Examiner in His Next Office Action

The present application has been pending for six and a half years and has received eight Office Actions. Counsel and Applicant's technical representative, Dr. Ugolick, have conducted numerous personal and telephone interviews with the Examiner on this and related applications. A primary issue is whether certain phrases/clauses/words in the claims are to be accorded no patentable weight because they are not "positive limitations" as the Examiner contends and with which Applicant

disagrees. Applicant earlier submitted a Declaration of Dr. Ugolick explaining how they are structural limitations. Further, Counsel has conducted legal research on the issue and particularly on the case cited by the Examiner, and has included the results of this research in the present Amendment. Even further, a detailed discussion of MPEP sections is provided above.

Thus, to advance prosecution and reduce the issues and to better understand the Examiner's (and thus the PTO's position) on this issue, it is respectfully requested that if the Examiner continues to take the same or similar position in his next Office Action that instead of just repeating his "it is not a positive limitation" rejection statement, that he:

(1) Directly respond to the analysis of the law of the Federal Circuit and the CCPA and the Board decisions discussed above, and point out specifically where the analysis is wrong and why and provide case law support therefor;

(2) Directly respond to the analysis above of the MPEP sections 2173.05(g) and 2111.04, and specifically point out where the analysis is wrong and why;

(3) Directly respond to the analysis in Dr. Ugolick's Declaration where he explains in detail why the phrases/clauses which the Examiner contends are not positive limitations to be structural limitations as they depend on many, if not all, of at least the following structural features, as would be apparent to those skilled in the art: (a) depth of the cut line; (b) width of the cut line; (c) the material of the breakable layer; (d) the properties of the top (paper) sheet; (e) the thickness of the breakable layer; (f) if any adhesive is used, the properties of the adhesive; and (g) the depth of penetration, if any, of the die cut into the breakable layer. The Examiner has not responded, addressed or mentioned the above-quoted points (a) -(g). If in his next action he continues to contend that these phrases/clauses are not positive limitations, he is respectfully requested to directly respond to points (a)-(g).

(4) Directly respond to the analysis in Dr. Ugolick's Declaration where he says that Mihara *et al.* would not and does not have the ability to split on at least portions of the first, second, third or fourth cut lines when the sheet structure or a portion thereof is

bent on the first, second, third or fourth cut lines upwardly only once or downwardly only once, as would be understood by those skilled in the art.

(5) Directly respond to the analysis in Dr. Ugolick's Declaration where he says "Mihara *et al.* does not describe a construction which splits, divides or separates into attached first and second layer portions when folded, and specifically when folded or bent upwardly only once or downwardly only once, as would be understood by those skilled in the art. Cut 2 of Mihara is provided to separate the adhesive label 9 from the release sheet 5. (See Abstract; col. 3, lines 18-21; col. 3, lines 49-54; and col. 5, lines 50-55.) In fact, Mihara *et al.* does not want the release sheet 5 to break or split at the cuts 2 as this would make it more difficult to initiate removal of the labels from the release sheet by separating an easily graspable portion of the label from the release sheet. That is, users want to be able to easily grasp and peel off a unitary predefined sheet adhesive sheet portion or label without fracturing the release sheet in a Mihara *et al.* type of construction. If a portion of the release sheet were to crack and break off and remain adhered to the label, it would defeat the purpose of the Mihara cuts 2, which is to facilitate removal of the labels from the release sheet."

(6) Since this is an eighth Office Action and since this application has been pending for six and a half years, it is requested that the Supervisory Patent Examiner co-sign the next Office Action. This request is made with reference to MPEP 707.02

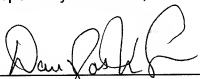
Concluding Remarks

Accordingly, it is respectfully contended that all of the claims now pending are in condition for allowance. Issuance of the Notice of Allowance at an early date is thus in order.

If there are any remaining issues, the Examiner is encouraged to telephone the below-signed counsel for Applicant at (310) 785-5384 to seek to resolve them.

The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. 10-0440. Should such additional fees be associated with an extension of time, Applicant respectfully requests that this paper be considered a petition therefor.

Respectfully submitted,



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